



Paper No. 5

MOTOROLA INC
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LAW SECTION
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COPY MAILED**FEB 5 2002****OFFICE OF PETITIONS**

In re Application of
Shahar, et al.
Application No. 09/884,377
Filed: June 18, 2001
Attorney Docket No. SC0355WI

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: DECISION ON PETITION
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This is a decision on the petition filed September 4, 2001, which is properly considered as a petition under 37 C.F.R. §1.53(e)(2) to accord the above-identified application a filing date of June 18, 2001.

Application papers in the above-identified application were filed on June 18, 2001. However, on August 17, 2001, the Initial Patent Examination Division (IPED) mailed a "Notice of Incomplete Nonprovisional Application," notifying applicant that the application papers had not been accorded a filing date because the application was deposited without drawings.² In addition, a new oath or declaration was required as the one submitted was unsigned.

In reply, applicants filed the instant petition. It is noted that no oath or declaration was received with the petition. On petition, applicants maintain that the application as filed on June 18, 2001, included one page of drawings as evidenced by the USPTO returning a postcard that accompanied the application that listed the items sent to the USPTO. In support thereof, petitioner submitted a copy of their postcard receipt identifying this application by serial number, itemizing "Formal Drawings (1 pg.)" among the enclosures, bearing a United States Patent and Trademark Office receipt date-stamp of June 18, 2001, and lacking any notation of non-receipt of any item listed.

A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the Office of all items listed thereon on the date stamped thereon by the Office. See MPEP 503. Applicant has shown that the application as filed on June 18, 2001 included one

¹ §1.53(e)(2) provides that "Any request for review of a notification pursuant to paragraph (e)(1) of this section, or a notification that the original application papers lack a portion of the specification or drawing(s), must be by way of a petition pursuant to this paragraph. ... In the absence of a timely (§1.181(f)) petition pursuant to this paragraph, the filing date of an application in which the applicant was notified of a filing error pursuant to paragraph (e)(1) of this section will be the date the filing error is corrected."

² See 35 U.S.C. 111(a)(4).

sheet of formal drawings, and thus, is entitled to a filing date of June 18, 2001.

In view thereof, the petition is GRANTED.

Given the basis for granting the petition, no petition fee is due and none has been charged.

In response to the filing of the petition, on October 16, 2001, IPED mailed a "Notice to File Missing Parts of Nonprovisional Application," informing applicant that a filing date of September 4, 2001 had been accorded but an executed oath or declaration (and surcharge for late filing) was still required.

To the extent that the Notice stated that the application is entitled to a filing date of September 4, 2001, the Notice was mailed in error and is hereby VACATED. However, the Notice was correct in stating that a signed oath or declaration is still required³. The two-month period for reply set in the "Notice to File Missing Parts of Nonprovisional Application" mailed October 16, 2001, continues to run from the mail date of that Notice, with extensions of time obtainable under \$1.136(a). **Failure to file a timely and proper response will result in abandonment of the application.**

The application is being forwarded to the Office of Initial Patent Examination (OIPE) for:

- further processing with a filing date of June 18, 2001, using the application papers received in the Office on that date and the one sheet of drawings resubmitted on petition filed September 4, 2001;
- vacating the "Notice to File Missing Parts of Nonprovisional Application" mailed October 16, 2001, to the extent that it accords a filing date of September 4, 2001;
- to await a proper response, an executed oath or declaration, to the "Notice to File Missing Parts of Nonprovisional Application" mailed October 16, 2001.

Applicant will receive appropriate notifications regarding the fees owed, if any, and other information in due course from OIPE.

Telephone inquiries related to this decision should be directed to Petitions Attorney Nancy Johnson at 703-305-0309.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

³ Pursuant to the general authorization to charge fees due in the application file, the Office could have charged the surcharge under \$1.16(a). It is requested rather that applicant reply to the Notice with the required oath or declaration and an authorization to charge the surcharge.